UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,378	12/18/2001	Mark J. Harris	26769-4	7906

21130 7590 07/01/2005

BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP
ATTN: IP DEPARTMENT DOCKET CLERK
2300 BP TOWER
200 PUBLIC SQUARE
CLEVELAND, OH 44114

EXAMINER	
NGUYEN, QUYNH H	
ART UNIT	**PAPER NUMBER**
2642	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/018,378
Filing Date: December 18, 2001
Appellant(s): HARRIS, MARK J.

W. Scott Harders
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/28/05 appealing from the Office action mailed 7/27/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct. Examiner notes that the language "*ordered in a typical way*" (Summary, line 2) is vague and no "*typical way*" is recited in the claims. The claims merely recite *"an order".*

(6) Claims on Appealed

This appeal involves claims 1-14.

(7) Prior Art of Record

5,974,453	ANDERSEN ET AL.	10-1999

(8) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-14 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 2/27/04.

Claim Rejections - 35 USC § 103

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersen et al. (U.S. Patent 5,974,453).

Note that Appellant argued only the rejection of claims 1, 7, and 10.

Regarding claims 1 and 10, Andersen et al. teach receiving a telephone number portion identifying a device (Fig. 4, 405 - where Andersen discussed *phone number 011-123-456-7890 identifying device 115*); [The phone number is arranged as "country code", area code, exchange, number]; converting ("*rearranging*") the telephone number portion into a multiple level domain name identifying the device over a network, the multiple level domain name comprising a plurality of domains corresponding to the telephone number portion and a base portion (col. 3, lines 29-41, col. 6, lines 60-66 and col. 8, lines 3-31, *for example, 7890.456.123.011.dir-con.com*); [This is a reverse order: number, exchange, area code, "country code"]; and establishing communication with the device via the multiple level domain name over the network (col. 3, lines 37-48).

However, Andersen et al. do not expressly suggest the plurality of domains corresponding to the telephone number portion are arranged "in an order" corresponding to the telephone number portion.

On one hand, "an order" corresponding to the telephone number would read on the reverse "order" which is, indeed, taught by Andersen. A "reverse order" is still an "order". On the other hand, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the domains corresponding to the telephone number portion arranged in "an order" corresponding "directly" and "exactly" to the telephone number portion, or in a reverse order. Obviously, either "order" may be chosen without departing from the teachings of Andersen. A "direct" or "exact" order, although not claimed, may have an obvious and apparent slight advantage over the reverse order. That is, the use of the argued but not claimed "direct" and "exact" order is obviously desirable because it may require "less" re-arrangement.

Claim 7 is rejected for the same reasons discussed above with respect to claim 1. Furthermore, Andersen et al. teach determining availability of the second device the on the network (col. 8, lines 19-31); and in response to the determining step, selectively establishing communications from the first device to the second device (col. 8, lines 44-51).

(9) Response to Argument

Regarding Appellant's statement under Brief Discussion of Reference (Brief, page 5) that "...*the domain name produced by Andersen '453 may incorporate elements of a phone number, but the elements are scrambled [Emphasis added]...*". Examiner respectfully submits that the domain produced by Andersen (col. 6, lines 60-66) is arranged in a "reverse order". A "reverse order" is still an "order" and the elements of a phone number are not scrambled. The order of "country code" 011, area code 123, exchange 456, and number 7890 (011-123-456-7890) is reversed as number 7890, exchange 456, area code 123, and "country code" 011 (7890.456.123.011). The word "scramble" mischaracterizes the reference.

Appellant argues (Brief, pages 5 and 6) that "...*there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art...*". In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the domains corresponding to the telephone number portion arranged in "an order" corresponding "directly" and "exactly" to the telephone number portion, or in a reverse order.

Obviously, either "order" may be chosen without departing from the teachings of Andersen. A "direct" or "exact" order, although not claimed, may have an obvious and apparent slight advantage over the reverse order. That is, the use of the argued but not claimed "direct" and "exact" order is obviously desirable because it may require "less" re-arrangement.

Regarding Appellant's statement (Brief, page 7) that "*...Andersen '453 lists among the problem it sought to overcome the 'inability to scale...' (Exhibit B, Column 1, line 49, 50. With this problem in mind, Andersen '453 notes in the Detailed Description that...*". Examiner respectfully submits that this is totally irrelevant to the claimed invention.

Regarding Appellant's statement (Brief, page 7) with respect to independent claims 1, 7, and 10 that the claims recited "the phone number could be maintained in an order corresponding...", "domain name arranged in an order corresponding to that of the telephone number portion", and "sequencing of the telephone number portion". Again, Examiner respectfully submits that the domain produced by Andersen (col. 6, lines 60-66) is arranged in a "reverse order". Generally, ascending, descending, upward, downward, right-left, or left-right is an "order". Arranging the telephone number in different orders to form DNS name is merely a decision of the system designer or user. What Andersen teaches is absolutely "an order".

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Quynh H. Nguyen
June 27, 2005

Conferees
Ahmad Matar
Supervisory Patent Examiner

AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Fan Tsang
Supervisory Patent Examiner

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Quynh Nguyen
Patent Examiner

Quynh Nguyen

BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP
ATTN: IP DEPARTMENT DOCKET CLERK
2300 BP TOWER
200 PUBLIC SQUARE
CLEVELAND, OH 44114